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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,271	02/28/2000	Raymond Senez	1782-014-999	9338

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NEW YORK, NY 100362711

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/06/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,271

Applicant(s)

SENEZ, RAYMOND

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-3 and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al. (US Pat. 6,173,272).

Claim 1: Thomas discloses a system for the automated payment of bills comprising:

- (a) a bill processing server connected to a network (service Bureau S, Fig. 1),
- (b) one or more financial institution servers connected to said network, wherein a client has at least one banking account associated with at least one of said one or more financial institution servers and a biller has at least one banking account associated with at least one of said one or more financial institution servers (Bank C and Bank B, Fig. 1);

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(c) one or more biller servers connected to said network, wherein said client has at least one billing account associated with at least one of said one or more biller servers (Biller B, Fig. 1);

(d) at least one client computer connected to said network (Consumer C, Fig. 1);

wherein said one or more biller servers includes means to format bill information and bill payment instructions associated with said at least one billing account (part of Bill, shown in Fig. 1);

and wherein said bill information further includes means for initiating bill payment instructions(part of Bill, shown in Fig. 1);

and wherein said at least one client computer comprises a processor, communication means, a server access program and a display for receiving and viewing from said one or more biller servers said bill information, and input means for selecting said means for initiating bill payment instructions (consumer C a component of the "Electronic home banking system" refer to col. 1 and 2, therefore "consumer" is equivalent to a client computer who initiates "bill payment order", therefore the means recited herein are inherent);

and wherein said processor integral to said at least one client computer is responsive to said input means and causes said communication means to communicate said bill payment instructions to said bill processing server when said means for initiating bill payment instructions is selected (communication by the consumer C to affect a bill payment);

and wherein said bill processing server causes a selected one of said at least one client banking account to be debited and a selected one of said at least one biller banking account to be credited, upon receipt of said bill payment instructions (consumer C a component of the "Electronic home banking system" refer to col. 1 and 2, therefore "consumer" is equivalent to a client computer who initiates "bill payment order", therefore the means recited herein are inherent);

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and wherein said bill processing server reports to a selected one of said one or more biller servers a selected one of said at least one billing account associated with said biller and a credit amount (col. 2 L 45-55, this refers to "service Bureau ... confirming receipt of the bill pay order, also note that reporting of consumer payment after it is processed is essential to maintain biller's own billing records such as proper crediting the consumer account);

and wherein said bill processing server reports to a selected one of said at least one client computer a selected one of said at least one billing account associated with said client and a debit amount (col. 3 L 27- col. 44, receipt of the bill pay order).

Claim 2. The system of claim 1 further including a database integral to said bill processing server for correlating said at least one client billing account stored in said bill payment instructions with a unique alphanumeric identifier assigned to said client and stored in said bill processing server, wherein said client is identified by said bill processing server when said bill payment instructions are received by said bill processing server and wherein a confirmation message is sent to said client upon identification of said client, and wherein said client confirms said bill payment instructions prior to said bill processing server debiting and crediting said client and biller banking accounts respectively (refer to col. 2 L 45-55, C-B account number).

Claim 3. The system of claim 1 wherein information identifying said client and said biller banking accounts are stored in said bill processing server (inherent because S, Fig.1 facilitates transfer of funds from consumer C account (Bank C) to Biller B's account (Bank B)).

As per claims 14-16: all limitations have been analyzed as per corresponding system claims 1-3.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Thomas as applied to claim 1 above, and further in view of Remington et al. (US Pat. 6,070,150).

Thomas fails to disclose at least explicitly that the bill information is a bill image and that the bill payment instructions is an HTML form. However, note that presentment of a bill image and bill payment instructions in an HTML form have been known in the art well before the priority date of the instant application. As an example, Remington et al. teaches an electronic bill presentment and payment system wherein the bill image and payment instructions are transmitted to a customer over the Internet (abstract). Bill image is presented to a client (customer) (abstract) and payment instructions are in the HTML form (refer to linkages 226-232 etc. on Fig. 7). The World Wide Web as a network and said server access program as a web browser are discussed (col. 5) as all other features recited in claims 6-13 are either inherent to the Remington system or well known in the art at the time of the instant claimed inventions and the examiner takes official notice of to that effect.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the features recited in claims because implementing the bill payment system on the Internet via WWW would enable large number of clients (who have access to personal computers or other means of access to the Internet) to interact with the bill processing server. Implementing the bill payment system over the Internet with associated web page of the bill processing server and HTML links would provide convenience to the clients (at their computers) for receiving and reviewing all pertinent billing information and subsequently making payment to the billers.

As per claims 17-26: all limitations have been analyzed as per corresponding system claims 4-13 as discussed above.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

November 1, 2002